

REMARKS

This is a full and timely response to the outstanding Office action mailed May 23, 2005. Upon entry of the amendments in this response claims 1-3, 6-8, 15, and 21-42 are pending. More specifically, claims 1-3, 21, 22, 34-36, and 42 are amended. These amendments are specifically described hereinafter. It is believed that the foregoing amendments add no new matter to the present application. Other statements not explicitly addressed herein are not admitted.

I. Present Status of Patent Application

Claims 1-3 are objected to for informalities. Claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Arnold (U.S. Patent No. 6,275,848) in view of Lafe (U.S. Patent No. 6,449,658). Claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Beyda *et al.* (U.S. Patent No. 6,275,850) in view of Hanson *et al.* (U.S. Patent No. 6,549,957). These rejections are respectfully traversed.

II. Rejections Under 35 U.S.C. §103(a) and Arnold**A. Claims 1-3, 6-8, and 15**

The Office Action rejects claims 1-3, 6-8, and 15 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Arnold* (U.S. Patent No. 6,275,848) in view of *Lafe* (U.S. Patent No. 6,449,658). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 1 as amended recites:

1. A method for automatically managing an electronic mail server application on a host computer, comprising the steps of:

checking an electronic mail message against a predetermined criteria;

determining whether the message has been previously compressed; and

compacting a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied and if the message has not been previously compressed.

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical.*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicant respectfully submits that independent claim 1 is allowable for at least the reason that the combination of *Arnold* and *Lafe* does not disclose, teach, or suggest at least **determining whether the message has been previously compressed; and compacting a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied and if the message has not been previously compressed.**

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 1. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 1 is allowable.

Because independent claim 1 as amended is allowable over the cited art of record, dependent claims 2-3, 6-8, and 15 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-3, 6-8, and 15 contain all the steps/features of independent claim 1. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, the rejection to claims 2-3, 6-8, and 15 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 2-3, 6-8, and 15 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 2-3, 6-8, and 15 are allowable.

B. Claims 21-23, 26-28, and 30-34

The Office Action rejects claims 21-23, 26-28, and 30-34 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Arnold* (U.S. Patent No. 6,275,848) in view of *Lafe* (U.S. Patent No. 6,449,658). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 21 as amended recites:

21. A method for managing a user's electronic mailbox on a computer, comprising the steps of:

performing an off-peak hours routine for checking an electronic mail message against a predetermined criteria; and

compressing a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied, wherein the step of compressing the electronic mail message is performed by searching for repeated patterns in the electronic mail message and encoding those patterns.

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 21 as amended is allowable for at least the reason that the combination of *Arnold* and *Lafe* does not disclose, teach, or suggest at least **performing an off-peak hours routine for checking an electronic mail message against a predetermined criteria**.

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 21. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 21 is allowable.

Because independent claim 21 as amended is allowable over the cited art of record, dependent claims 22-23, 26-28, and 30-34 (which depend from independent claim 21) are

allowable as a matter of law for at least the reason that dependent claims 22-23, 26-28, and 30-34 contain all the steps/features of independent claim 21. Therefore, the rejection to claims 22-23, 26-28, and 30-34 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 21, dependent claims 22-23, 26-28, and 30-34 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 22-23, 26-28, and 30-34 are allowable.

C. Claims 35-42

The Office Action rejects claims 35-42 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Arnold* (U.S. Patent No. 6,275,848) in view of *Lafe* (U.S. Patent No. 6,449,658). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 35 as amended recites:

35. A computer readable medium with logic embedded therein for executing on a computer for managing a user's electronic mailbox on a computer comprising:

logic configured to perform an off-peak hours routine to screen an electronic mail message against a predetermined criteria; and

logic configured to, if the predetermined criteria is satisfied, compress a non-attachment portion of the electronic mail message by finding repeated patterns in the message and encoding those patterns.

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 35 as amended is allowable for at least the reason that the combination of *Arnold* and *Lafe* does not disclose, teach, or suggest at least **logic configured to perform an off-peak hours routine to screen an electronic mail message against a predetermined criteria.**

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 35. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 35 is allowable.

Because independent claim 35 as amended is allowable over the cited art of record, dependent claims 36-42 (which depend from independent claim 35) are allowable as a matter of law for at least the reason that dependent claims 36-42 contain all the steps/features of independent claim 35. Therefore, the rejection to claims 36-42 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 35, dependent claims 36-42 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 36-42 are allowable.

III. Rejections Under 35 U.S.C. §103(a) and *Beyda*

A. Claims 1-3, 6-8, and 15

The Office Action rejects claims 1-3, 6-8, and 15 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Beyda* (U.S. Patent No. 6,275,850) in view of *Hanson* (U.S. Patent No. 6,549,957). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 1 as amended recites:

1. A method for automatically managing an electronic mail server application on a host computer, comprising the steps of:

checking an electronic mail message against a predetermined criteria;
determining whether the message has been previously compressed; and
compacting a non-attachment portion of the electronic mail message if
the predetermined criteria is satisfied and if the message has not been
previously compressed.

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 1 is allowable for at least the reason that the combination of *Beyda* and *Hanson* does not disclose, teach, or suggest at least **determining whether the message has been previously compressed; and compacting a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied and if the message has not been previously compressed.**

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 1. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 1 is allowable.

Because independent claim 1 as amended is allowable over the cited art of record, dependent claims 2-3, 6-8, and 15 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-3, 6-8, and 15 contain all the steps/features of independent claim 1. Therefore, the rejection to claims 2-3, 6-8, and 15 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 2-3, 6-8, and 15 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 2-3, 6-8, and 15 are allowable.

B. Claims 21-23, 26-28, and 30-34

The Office Action rejects claims 21-23, 26-28, and 30-34 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Beyda* (U.S. Patent No. 6,275,850) in view of *Hanson* (U.S. Patent No. 6,549,957). For the reasons set forth below, Applicant respectfully traverses the rejection. For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 21 as amended recites:

21. A method for managing a user's electronic mailbox on a computer, comprising the steps of:

performing an off-peak hours routine for checking an electronic mail message against a predetermined criteria; and

compressing a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied, wherein the step of compressing the electronic mail message is performed by searching for repeated patterns in the electronic mail message and encoding those patterns.

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 21 as amended is allowable for at least the reason that the combination of *Beyda* and *Hanson* does not disclose, teach, or suggest at least **performing an off-peak hours routine for checking an electronic mail message against a predetermined criteria.**

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 21. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 21 is allowable.

Because independent claim 21 as amended is allowable over the cited art of record, dependent claims 22-23, 26-28, and 30-34 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that dependent claims 22-23, 26-28, and 30-34 contain all the steps/features of independent claim 21. Therefore, the rejection to claims 22-23, 26-28, and 30-34 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 21, dependent claims 22-23, 26-28, and 30-34 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct

from the cited art of record. Hence there are other reasons why dependent claims 22-23, 26-28, and 30-34 are allowable.

C. Claims 35-42

The Office Action rejects claims 35-42 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Beyda* (U.S. Patent No. 6,275,850) in view of *Hanson* (U.S. Patent No. 6,549,957). For the reasons set forth below, Applicant respectfully traverses the rejection. For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 35 as amended recites:

35. A computer readable medium with logic embedded therein for executing on a computer for managing a user's electronic mailbox on a computer comprising:

logic configured to perform an off-peak hours routine to screen an electronic mail message against a predetermined criteria; and

logic configured to, if the predetermined criteria is satisfied, compress a non-attachment portion of the electronic mail message by finding repeated patterns in the message and encoding those patterns.

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 35 as amended is allowable for at least the reason that the combination of *Beyda* and *Hanson* does not disclose, teach, or suggest at least **logic configured to perform an off-peak hours routine to screen an electronic mail message against a predetermined criteria.**

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 35. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 35 is allowable.

Because independent claim 35 as amended is allowable over the cited art of record, dependent claims 36-42 (which depend from independent claim 35) are allowable as a matter of law for at least the reason that dependent claims 36-42 contain all the steps/features of independent claim 35. Therefore, the rejection to claims 36-42 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 35, dependent claims 36-42 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 36-42 are allowable.

IV. Miscellaneous Issues

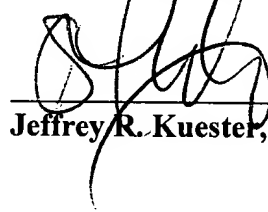
Claim 1 has been amended by adding “automatically managing” in the preamble to overcome the objections to claims 1-3.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,



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